IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s)	: Bruce H. HANSON et al.	Group Art Unit: 3653
Appln. No.	: 10/630,940	Examiner: Mark Hageman
Filed	: July 31, 2003	Confirmation No.: 1862
For	: SEQUENCING SYSTEM AND METHOD OF USE	

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer dated August 21, 2007, the period for reply extending until October 22, 2007 (October 21 being a Sunday).

In the Examiner's Answer, the rejection of claims 1-23 under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 6,107,588 issued to De Leo et al. in view of U.S. Publication No. 2002/0104782 to DeWitt is maintained. Also, the rejection of claims 1-23 under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 6,274,836 issued to Walach in view of U.S. Publication No. 2002/0104782 to DeWitt is maintained.

Appellants note this Reply Brief is being filed under 37 C.F.R. §41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

Appellants argued that DeWitt's chutes 460 do not constitute input feeding devices, as recited in the claimed invention (see, e.g., Appeal Brief pages 10-11). The Examiner maintains the position that DeWitt's drop chutes 460 constitute input feeding devices as recited in the claimed invention. More specifically, the Examiner explains:

> ...the chutes are "input feeding devices" in that they provide a means by which items are fed or input into the apparatus ... the language of the claims does not require automatic feeders or any specific processing rates etc. that would preclude the chutes from being considered input feeding devices.

(Examiner's Answer, page 19).

Appellants respectfully disagree with the contention that DeWitt's drop chutes 460 constitute "input feeding devices," and submit the Examiner is applying an improper interpretation to the term "input feeding device." Because DeWitt's chutes 460 do not constitute input feeding devices, DeWitt does not disclose or suggest *feeding rejected product to at least one output bin of the plurality of output bins in a single group accessible to any of the plurality of input feeders*, as recited in representative claim 1.

Appellants acknowledge that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification (see, e.g., MPEP §2111). However, Appellants submit that the Examiner's interpretation of the term "input feeding devices" is not consistent with the specification of the present application or the interpretation which would be given by one of ordinary skill in the art.

For example, the input feeding devices of the present invention are described as devices having a feed rate capacity of approximately 10,000 letters per hour, optionally including a pause

device as well as an inserter and optical reader, and being controlled by a controller. More specifically, Appellants' specification states:

> Referring now to FIG. 1, a general schematic diagram of a sequencing system is shown. In the embodiment of FIG. 1, the sequencing system is generally depicted as reference numeral 100 and includes a plurality of induction points or input feeding devices 102a, 102b, 102c and 102d. In the embodiment of FIG. 1, four input feeding devices are shown for illustration; however, the sequencing system may use any number of input feeding devices such as two, three or more input feeding devices depending on the particular application. In one embodiment, the input feeding devices each have a feed rate capacity of approximately 10,000 letters per hour, and may include a pause device "P" as well as an inserter "I" and an optical reader "O" such as an optical recognition reader (OCR), all communicating and controlled by a controller "C". Those of ordinary skill in the art should recognize that other feeding capacity rates may also be used with the invention, and that the input feeding devices illustrated herein are provided for showing an exemplary description of the invention.
>
> Referring still to FIG. 1, a conventional type transporting system 104 is provided for transporting the products between the input feeding devices and output bins 106. In one aspect of the invention, the products, of product stream "PS", are inducted into any of the input feeding devices via the inserters "I" in any random order. The OCR will read a code associated with each of the products such as an address code or the like, and thereafter the product will be transported to a respective output bin 106 via the transporting system 104 under the control of controller "C".

(page 7, lines 4-27)

Moreover, representative claim 1 recites input feeding devices each randomly receiving product from a stream of product. DeWitt's chutes 460 do not receive product from a stream of product. Instead, De Witt's chutes 460 are arranged for a human operator to place documents in. Thus, the chutes 460 are for receiving documents, one at a time, from the hand of a human operator – not randomly from a stream of product, as recited in the claims and described in the specification.

Based upon the above-noted description of input feeding devices provided in Appellants' specification, and based upon the usage of the term in the claim, Appellants submit that DeWitt's

chutes 460 cannot reasonably be considered input feeding devices. As such, the rejection based upon DeWitt is improper because the Examiner's interpretation of the term "input feeding device" is inconsistent with the claimed invention and the specification. As the following passages of the MPEP make clear, the Examiner is not free to disregard the meaning given to a term in the specification simply for the purpose of conforming the applied art to a recited claim term:

> During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.

(MPEP §2111) [emphasis added].

> ...
>
> [T]he words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

(MPEP §2111.01) [emphasis added].

> ...
>
> The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327.

(MPEP §2111.01) [emphasis added].

> ...
>
> If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.")

(MPEP §2111.01) [emphasis added].

Moreover, Appellants note that looking to the specification for the purpose of interpreting or defining a recited claim term is not an improper attempt to read limitations from the specification into the claims. More specifically, MPEP §2111 notes:

> reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

Since the term "input feeding device" is explicitly recited in the claims, it is proper to look to the specification for guidance in interpreting this term. As such, when the term "input feeding device" is interpreted consistent with the specification and the other language in the claims, it is clear that DeWitt's chutes 460 do not constitute input feeding devices.

For all of the above-discussed reasons, Appellants submit that the Examiner is improperly interpreting the recited term "input feeding device." Since DeWitt's chutes 460 do not constitute input feeding devices, DeWitt does not disclose or suggest *feeding rejected product to at least one output bin of the plurality of output bins in a single group accessible to any of the plurality of input feeders*, as recited in the claimed invention (e.g., representative claim 1). Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Second Issue

Appellants argued that DeWitt's drop chutes 460 and reject bin 250 are disclosed in separate embodiments, and are not disclosed as usable together (Appeal Brief, page 11). The Examiner asserts that a reject bin 250 is accessible to the drop chutes 460. More specifically, the Examiner states:

> The [DeWitt] disclosure is not of a second distinct embodiment but rather a reorganization of the previously disclosed elements with some additional features to allow semi automated mail processing. DeWitt discloses many different systems and different modes of operations using all or some subset of these systems. Examiner therefore contends that the imaging system 480 and output bins 490 are no different than the earlier disclosed imaging system and stacker. Therefore examiner maintains that a reject bin is present and readily accessible to multiple input in the form of chutes 460.

(Examiner's Answer, page 20).

Appellants respectfully disagree, and submit that there is nothing in DeWitt to support the Examiner's assertion that the reject bin 250 of the first embodiment is accessible to the chutes 460 of the second embodiment. More specifically, Appellants note that the chutes 460 are first disclosed beginning with FIG. 19, which is disclosed as an "alternative embodiment" in the description of the drawings (paragraph 0042). Conspicuously absent from the description of the alternative "semi-automated" embodiment (e.g., FIGS. 19-22) is any mention of reject bin 250, or even rejected product in general.

Conversely, the first embodiment of DeWitt (e.g., FIGS. 1-18) discloses the use of a reject bin 250, but makes no mention whatsoever of chutes 460. Instead, in the first embodiment, a single envelope feeder 15 is utilized. Moreover, there is no language in DeWitt disclosing, or even implying, that features of the two separate embodiments can be used interchangeably. Nor has the Examiner identified any such passage in DeWitt. The Examiner's contentions are factually unsupported by the record, and appear to be mere speculation proffered in an attempt to conform the applied art to the claimed invention.

Therefore, DeWitt does not disclose or suggest *feeding rejected product to at least one output bin of the plurality of output bins in a single group accessible to any of the plurality of input feeders*, as recited in the claimed invention (e.g., representative claim 1). Accordingly, the

rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Third Issue

Appellants argued that the proposed combination of prior art would not inherently increase a capacity of processing points for sequencing the product during a second pass phase, but, rather, converting one of De Leo's bins (e.g., U_1) in each group to a reject bin would actually *decrease* capacity by taking away a possible delivery point (Appeal Brief pages 14-15). The Examiner acknowledges that converting one of De Leo's bins would decrease capacity, but contends the proposed combination does not convert one of De Leo's bins to a reject bin. The Examiner explains (for the first time) that:

> The combination does not use an existing bin as the reject bin but rather adds an additional reject bin to the already existing bins of De Leo. Examiner maintains that this addition, not conversion, of the bin will inherently increase the capacity of the apparatus.

(Examiner's Answer, page 22).

Appellants disagree with this assertion for a number of reasons. First, there is no disclosure or suggestion in the applied art of adding a new bin to already existing system of De Leo. Instead, the Examiner appears to be suggesting adding a new bin based solely upon information gleaned from Appellants' disclosure, which is an improper use of hindsight reasoning. In any event, there is simply no suggestion whatsoever that De Leo can use an additional bin. In fact, Appellants submit that De Leo would not use an additional bin as it would destroy the groupings of bins already contemplated by De Leo.

Second, De Leo explicitly teaches away from the proposed modification of adding a new bin that is separate from already exiting groups Wa, Wb. More specifically, De Leo expressly

states that in the second pass phase, postal objects from input feeder A can only be directed towards the output of subset Wa, and postal objects from input feeder B can only be directed toward the output of subset Wb (col. 5, lines 13-24). Thus, even if an extra reject bin were added to De Leo, the inputs A, B could not direct objects to that reject bin.

For example, if the Examiner's proposed extra reject bin were added to subset Wa, then, due to the above-noted constraints disclosed by De Leo, the extra reject bin would not be accessible by feeder B. Conversely, if the extra reject bin were added to the subset Wb, then the extra reject bin would not be accessible by input feeder A. Likewise, if the extra reject bin were added outside of subsets Wa and Wb, then neither feeder A, B would have access to the extra reject bin. Thus, regardless of where the Examiner's proposed extra reject bin is added, it will not be accessible by at least one feeder (A or B), and will not operate to increase the capacity of processing points for sequencing the product during a second pass phase, as recited in the claimed invention.

Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Fourth Issue

Appellants argued that the Examiner improperly treated the "means plus function" recitations, and that, in any event, what the Examiner considers as an equivalent does not perform the identical claimed function (Appeal Brief, pages 20-21). The Examiner argues that the referenced elements are equivalent to those claimed, and that the proposed combination will perform the claimed function (Examiner's Answer, pages 26-27).

Appellants respectfully disagree, and submit that the prior art structure/material/act identified by the Examiner does not perform the identical claimed function, and, therefore, cannot be considered an equivalent in terms of 35 U.S.C. §116, sixth paragraph. More specifically, claim 21 recites:

> means for permitting, in the second pass phase, rejected product of the plurality of product to an output bin common and accessible to any of the feeding means.

The Examiner admits that De Leo does not disclose or suggest any such means. However, the Examiner asserts that DeWitt does discloses this feature. More specifically, the Examiner states that:

> DeWitt discloses means for permitting rejected product of the plurality of product to an output bin (250) common and accessible to any of the feeding means (460 and para 105).

(Final Office Action, page 9; Appeal Brief, page 9).

Appellants respectfully disagree, and submit that DeWitt does not disclose means for permitting, in the second pass phase, rejected product of the plurality of product to an output bin common and accessible to any of the feeding means. *In re Donaldson*[1] and MPEP §2182 require that for a prior art element to be considered an equivalent under 35 U.S.C. §116, sixth paragraph, the prior art element must perform the **identical** claimed function.

Claim 21 recites a "means for permitting, *in the second pass phase*...". DeWitt does not disclose a second pass phase. Instead, DeWitt discloses that the envelopes pass through the machine a single time only. There is simply no mention of first and second passes in DeWitt. Therefore, DeWitt cannot reasonably be said to disclose a "means for permitting, *in the second*

[1] *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

pass phase...". As such, contrary to the Examiner's assertion, DeWitt does not disclose anything that performs the identical claimed function.

As the Examiner admits that De Leo does not disclose or suggest this means, and since DeWitt does not disclose an equivalent (i.e., a structure/material/acts that performs the identical claimed function in substantially the same way to achieve substantially the same result), Appellants submit that the applied art does not disclose or suggest this feature of the claimed invention.

Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Fifth Issue

Appellants argued that Walach does not disclose or suggest a plurality of input feeding devices each randomly receiving product from a stream of product (Appeal Brief, page 24). The Examiner argues that Walach discloses a plurality of input feeding devices each randomly receiving products from a stream of product. More specifically, the Examiner contends

> Walach discloses "providing a multiplicity of articles to be sorted," [and] that the articles to be sorted are being moved from one place to another through out the entire process and therefore there is a stream of product as it is moved throughout the sorting process.

(Examiner's Answer, pages 30-31).

Appellants respectfully disagree.

Appellants note that the Examiner's explanation amounts to an assertion of inherency. MPEP §2112 provides the following guidance regarding rejections based upon inherency:

> The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957

> (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

[emphasis added].

> ...
>
> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

[emphasis added].

Appellants respectfully submit that the Examiner's proffered reasoning that "the articles to be sorted are being moved from one place to another through out the entire process and therefore there is a stream of product as it is moved throughout the sorting process" is mere speculation, without any basis in fact or technical reasoning, as required by MPEP §2112. In fact, the Examiner's explanation does not even address the language of the claim. That is, the claimed invention (for example, independent claim 1) explicitly recites that the input feeders each randomly receive product from a stream of product. As such, each input feeding device must receive product from the same stream of product. The Examiner does not address the claimed relation between the input feeders and the stream of product. Instead, the Examiner merely surmises that there is a stream of product somewhere in Walach.

However, the claimed invention recites that the input feeders receive product from a stream of product. For example, as depicted in FIG. 1 of Appellants' invention, it is clearly seen that the input feeding devices 102a-d each receive product from a stream of product "PS". That

is, a single stream of product randomly provides mail pieces to each of the four input feeders. However, the Examiner's assertion of inherency does not address the claim language because it only discusses a stream of product, and does not discuss how all of the plural input feeding devices receive product from a stream of product. Since the Examiner's explanation does not address the actual claim language, Appellants respectfully submit that it cannot provide adequate basis in fact and/or technical reasoning to reasonably support the conclusion of inherency. In any event, Walach simply does not describe or imply a stream of product that feeds all input bins 10.

Moreover, regarding the "randomly receiving" language, the Examiner contends

> the articles are in no particular order prior to the first pass sort and that simply splitting a random pile of articles approximately in half creates two piles that are still random. Therefore, the splitting action does not prevent the articles from, "being randomly assigned to the input feeding devices."

(Examiner's Answer, pages 20-21).

Appellants respectfully disagree.

The Examiner's assertion directly contradicts the Examiner's own explanation regarding the stream of product. Here, the Examiner alludes to a "random pile of articles" in Walach. However, Appellants submit that a pile of articles does not constitute a stream of product, such that splitting a random pile of articles does not read on input feeding devices each randomly receiving products from a stream of product. Contrary to the claimed invention, Walach merely teaches that, before the first pass, the articles are divided approximately equally between the two input bins. This does not constitute, and appears to teach away from, a plurality of input feeding devices randomly receiving product from a stream of product, as recited in the claimed invention.

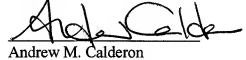
Therefore, Walach does not disclose all of the features of the claimed invention. Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

CONCLUSION

For the reasons expressed above, Appellants respectfully request that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

Respectfully submitted,
Bruce H. HANSON et al.



Andrew M. Calderon
Registration No. 38,093

October 22, 2007
Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
Telephone: 703-716-1191
Facsimile: 703-716-1180